

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed March 29, 2004. At the time of the Office Action, Claims 1-55 were pending in this Application. Claims 1-55 were rejected. Claims 1, 19-22, 25, 27, 30, 40, 43 and 46 have been amended to further define various features of Applicants invention. Claims 2, 3, 18, 31, 42, and 47 have been cancelled without prejudice or disclaimer. Applicants have added Claims 56 and 57. Applicants respectfully request reconsideration and favorable action in this case.

Rejections under 35 U.S.C. §102 or §103

Claims 1-55 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as being obvious over Wallys W. Conhaim's "Thomas Publishing" dated Jul/Aug 1998. ("Conhaim"). Applicants respectfully traverse.

Conhaim discusses the introduction of a limited function website by Thomas Publishing. Specifically, Conhaim discusses Thomas Publishing's introduction of a website for the Thomas Register of American Manufacturers seeking to provide a marketplace for industrial products and services. The Thomas Register of American Manufacturers, along with other Thomas publications described in the Conhaim article, is known "almost exclusively on providing industry with up-to-date product information". Users of the Thomas publications, either online or in print, seek to leverage Thomas' know-how and databases.

Thomas Register of American Manufacturers online provided searching capabilities, access to comparative listings, direct links to company information, catalogs, free literature via fax, electronic commerce capabilities and company websites. According to Conhaim, Thomas Publishing engages in electronic commerce as a vendor, selling its publications, and facilitates electronic commerce for its advertising clients. Conhaim also describes Thomas' Trading Process Network where subscribers can make negotiated deals. Thomas' Trading Process Network is also reported by Conhaim to provide Internet-based procurement services

for industrial material and to allow requests for proposal (RFPs) to be posted and bids to be submitted privately.

Regarding Applicants' claimed invention, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1997). Furthermore, "the identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Applicant respectfully submits that the Conhaim reference cited as anticipatory by the Examiner cannot anticipate the rejected Claims, because Conhaim does not show each and every element as set forth in the present Claims.

A finding of obviousness under 35 U.S.C. § 103(a) requires a demonstration of the scope and content of the prior art, the level of ordinary skill in the art, differences between the claimed subject matter and the prior art, and whether the differences are such that the subject matter as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made. *Graham v. Deere*, 383 U.S. 1 (1996). The relevant inquiry is whether the prior art both suggests the invention and provides one of ordinary skill in the art with a reasonable expectation that the suggestion would work. *In re O'Farrell*, 853 F.2d 1549, 7 USPQ2d 1673 (Fed. Cir. 1988). Both the suggestion and the reasonable expectation of success must be found in the prior art and not in Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In determining whether a claimed invention is obvious in light of a combination of references, the court must be vigilant not to allow hindsight to cloud the question. *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351 (Fed. Cir. 2001) (citing *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579 (Fed. Cir. 1997)). To prevent such "hindsight invalidation," courts require that there be some teaching, suggestion, or reason to combine cited references that are alleged to render the patent claim obvious. *McGinley*, 262 F.3d at 1351. Whether such a motivation to combine prior art references has been demonstrated is a

question of fact. *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1348 (Fed. Cir.), cert. denied, 530 U.S. 1238 (2000).

MPEP §2112 explicitly states that the "Examiner must provide a rationale or evidence tending to show inherency". More specifically, §2112 states:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)...; *In re Oelrich*, 666 F.2d 578, 581-21, 2212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however must not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted)... In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)(emphasis in original).

Applying the standards of 35 U.S.C. §§ 102(b) and 103(a) and MPEP 2112 to the Conhaim reference, the Examiner fails to show that Conhaim expressly or inherently anticipates or renders obvious each and every element of Applicants' independent Claims 1, 27, 30, 36, 40, 43, 46 and 52 as reflected in the listing of Claims presented above.

In particular, the Examiner fails to show where Conhaim discloses input from a purchaser identifying a service relating to industrial equipment acquisition or use, information relating to the nature of the equipment for which services are sought and transmitting to at least one service provider information relating to the nature of the equipment as to which services are to be rendered as in Claims 1, 27, 30, 36, 40, 43, 46 and 52. Nowhere does the Examiner point out where Conhaim describes more than a website serving as more than a searchable information repository or simple electronic commerce transaction facilitator. The Examiner's inherency argument must also fail as the Examiner has not shown that Conhaim *necessarily* performs/provides for each and every element of Applicants' claimed invention. At best, the Examiner raises nor more than a mere *possibility*

of similarities between Applicants' invention as claimed and the disclosure of Conhaim. Accordingly, Applicants respectfully request that the Examiner reconsider the rejections to 1, 27, 30, 36, 40, 43, 46 and 52, withdraw the rejections and allow 1, 27, 30, 36, 40, 43, 46 and 52.

Claims 4-17 depend from and provide further patentable limitations to allowable independent Claim 1. Claims 28 and 29 depend from and provide further patentable limitations to allowable independent Claim 27. Claims 32-35 depend from and provide further patentable limitations to allowable independent Claim 30. Claims 37-39 depend from and provide further patentable limitations to allowable independent Claim 36. Claim 41 depends from and provides further patentable limitations to allowable independent Claim 40. Claims 44 and 45 depend from and provide further patentable limitations to allowable Claim 43. Claims 48-51 depend from and provide further patentable limitations to allowable independent Claim 46. Claims 53-55 depend from and provide further patentable limitations to allowable independent Claim 52. Accordingly, Applicants respectfully request that the Examiner withdraw the rejections to Claims 4-17, 28, 29, 32-35, 37-39, 41, 44, 45, 48-51 and 53-55 and allow Claims 4-17, 28, 29, 32-35, 37-39, 41, 44, 45, 48-51 and 53-55.

Claims 18 and 42 have been cancelled without prejudice or disclaimer. Claims 19-26 have been amended to depend from newly added Claim 56.

Newly Added Claims

Applicants have added Claims 56 and 57. Applicants respectfully request that the Examiner consider and allow newly added Claims 56 and 57.

CONCLUSION

Applicants have now made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicants respectfully request reconsideration and allowance of the Claims as presented herein.

Applicants believe there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees to Deposit Account No. 50-2148 of Baker Botts L.L.P. in order to effectuate this filing.

ATTORNEY DOCKET
071308.0376

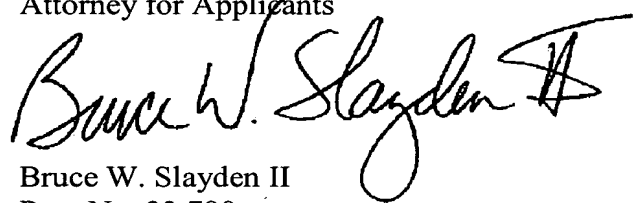
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If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2606.

Respectfully submitted,

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A handwritten signature in black ink, reading "Bruce W. Slayden II". The signature is stylized with a large, looped "B" and a long, sweeping underline that extends to the right.

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